

I. A *prima facie* case of obviousness has not been established

To establish a *prima facie* case of obviousness, the Court of Appeals for the Federal Circuit, in *In re Vaeck*, has made it clear that three basic criteria must be met:

- there must be some suggestion or motivation, contained in the reference itself, to modify the reference;
- there must be a reasonable expectation of success with the modification; and
- the prior art reference must teach or suggest all claim limitations of the present invention.

For at least two (2) of the above reasons, no *prima facie* case of obviousness has been established here. First, Hayashi fails to teach or suggest all claim limitations of the present invention, namely an outer cover hardness of greater than about 56 Shore D, as recited in claims 1 and 18. This fact is even recognized and acknowledged by the Examiner in the Office Action: “Hayashi *et al.* does not disclose an outer cover having a hardness greater than about 56 Shore D.” Second, there is no suggestion or motivation in Hayashi to modify the reference because Hayashi *teaches away* from such a modification – Hayashi discloses an outer cover having a hardness of 35 to 53 Shore D.

The Examiner contends that because Hayashi discloses that having a hard inner cover and soft outer cover improves the spin performance, hitting feel and maintains satisfactory flight performance, that it would have been obvious to one of ordinary skill in the art to have an inner cover harder than the outer cover – Applicants do not disagree. However, this realization is not sufficient to render the claims of the present invention obvious. Were claims 1 and 18 to stop short of its current state and recite specifically that the inner cover is harder than the outer cover, the Examiner may be correct. This is not the case, however, because claims 1 and 18 of the present invention further recite an outer cover having a hardness of greater than 56 Shore D. Hayashi does not teach at least this element.

For at least these reasons, Applicants believe that a *prima facie* case for obviousness has not been established and that claims 1 and 18, and the claims depending therefrom, are believed

to be in condition for allowance. As such, the rejection under 35 U.S.C. § 103(a) is believed to have been overcome and Applicants respectfully request reconsideration and withdrawal thereof.

II. Applicants' disclosure has incorrectly and inappropriately been relied upon

In the Office Action, the Examiner incorrectly states that a harder inner layer and softer cover layer is taught by Applicants in Table II for the ball labeled 'Control' – this is incorrect because no inner cover hardness value is listed. Even assuming *arguendo* that an inner cover hardness were listed, and that it was a value harder than that of the cover, it is well established that the teaching or suggestion to make the claimed modification to the primary reference must be found in the prior art, and not Applicants' disclosure. The Examiner cannot resort to Applicants' own teaching to suggest how to modify the prior art in order to reject Applicants' claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540 (Fed. Cir. 1983).

III. The Examiner has failed to meet the required burden of proof

It is also well established that the burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. To support the conclusion that the claimed invention is directed to obvious subject matter, the primary reference must either expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the prior art references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Neither of these elements exist here.

Moreover, the Examiner must provide evidence that, as a whole, shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not. See M.P.E.P. § 2142. This level of proof has not been established. Not only does the primary reference relied upon not teach the claimed invention, it *teaches away* from it. The Examiner has failed to provide any teaching that would suggest changing it.

CONCLUSION

For at least the reasons set forth above, Applicants believe that the rejection has been overcome and that the claims of the subject application are now in condition for allowance.

Should the Examiner have any further concerns or believe that a discussion with Applicants' Agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

No fee is believed to be due for this submission. Should any fees be required, however, please charge the required fees to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,



Date: October 29, 2002

William B. Lacy (Reg. No. 48,619)
Acushnet Company
333 Bridge Street
Fairhaven, MA 02719
508-979-3540